REMARKS

Claims 19 and 43 are pending in the Application. Claims 19 and 43 were previously allowed by the Examiner, but later rejected in the Office Action of July 9, 2004 in view of a newly discovered reference. Applicant respectfully requests that the Examiner reconsider the rejection in view of the amendments made herein.

I. Response to Claim Rejections under 35 USC §112

The Examiner rejected claim 43 for indefiniteness arising from lack of antecedent bases for the terms "the delivered message" and "pre-cached message". In response, Applicant has amended claim 43 by modifying each of these terms with the adjective "sponsored" as suggested by the Examiner. Applicant therefore requests that the §112 rejection be withdrawn.

II. Response to Rejections Under 35 USC §103

The Examiner rejected claims 19 and 43 under 35 USC §103 for obviousness over Hendricks et al (U.S. Patent No. 6,463,585) in view of Zigmond et al. (U.S. Patent No. 6,698,020). The Examiner cites to Hendricks et al (hereafter "Hendricks") for its teachings related to television delivery systems for targeted advertisements, and to Zigmond et al (hereafter "Zigmond") for its teachings related to providing log-in protocols for television viewers.

According to MPEP § 706.02(j), for a claim to be obvious, there must be: (a) a suggestion or motivation to combine reference teachings; (b) a reasonable expectation of success; and (c) the references must teach all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, *e.g.*, *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Claim Amendments in Response to Rejections Under 35 USC §103

Applicant has amended claims 19 and 43 to more clearly distinguish the present invention over the Hendricks reference.

Claim 19 has been amended in steps (b) and (e) by replacing the term "delivering viewing behavior information" with the term "delivering, after login, viewing selection information". Claim 19 has also been amended in steps (g) and (h) by replacing the term "behavior" with the term "selection". Claim 19 has also been amended in step (i) by inserting the term "responsive to the delivered after login viewing selection information of the first viewer" immediately following the term "delivering".

These amendments to claim 19 more clearly describe the *dynamic insertion* methodology of the present invention, as the title suggests. That is, the novelty of the invention lies in its ability to tailor its targeted messages according to viewer selections that occur within the time frame of a login session. It accomplishes this by monitoring a viewer's selections in real time to capture the viewer's instantaneous interests. Thus, as a viewer's preferences change from day to day, or even within a single login session, the targeted messages also change. These amendments are fully supported in the Specification, e.g., at p.3, ln. 20-21 ("the viewing information is continually updated each time the viewer logs onto a viewing system").

Claim 19 has also been amended in step (i) by replacing the term "break" with the term "downloading delay". This amendment distinguishes *planned* program breaks typical in television broadcasting, from *unplanned* programming breaks unique to Internet broadcasts. Downloading delays are unplanned breaks brought about by various processing delays in the client/server computer systems.

Claim 43 has been similarly amended in the final "wherein" clause, by replacing the term "break" with the term "downloading delay". The amendments to claim 19 and 43 that replace "break" with "downloading delay" are fully supported in the Specification, e.g., at p.2, ln.30 to p.3, ln.16.

b. <u>In view of the Amendments, Hendricks and Zigmond cannot form the basis for a §103(a) rejection because they fail to teach or suggest all elements of claim 19</u>

In response to the rejection of claim 19, Applicants submit that the combination of Hendricks and Zigmond fails to anticipate every element of claim 19, as amended. In particular, neither reference anticipates or suggests (1) compiling viewing habits *dynamically*, or (2) presenting multimedia messages during *downloading* breaks in program transmissions.

The concept of compiling viewing habits dynamically is claimed in claim 19 in steps (b) and (e), as follows:

"delivering, after login, viewing selection information of the first viewer" and

"delivering, after login, viewing selection information of the second viewer."

On page 4 of the Office Action, the Examiner notes that Hendricks makes use of a viewer's viewing habits, and cites to col.66, ln.16-66; col.67, ln.1-4; col.68, ln.48-55; col.69, ln.61-67; and col.74, ln. 62-67. However, nowhere in any of these cited passages, nor anywhere else in the Hendricks patent, does Hendricks anticipate or suggest that viewer selection information be delivered by a viewer *after login*, concurrently while viewing the multimedia broadcast. To the contrary, all that Hendricks suggests is that viewing habits can be collected after the fact using questionnaires sent by mail, or by statistically analyzing viewer access *history* and *programs watched* (i.e. past tense) using some sort of algorithm. *See* Hendricks, col.66, ln.58-66. Hendricks then suggests that "[v]arious viewers or viewer categories can *later* be targeted with different advertisements" (col.67, ln.3-4) ... based on *historical* viewing data (col.69, ln.66) ... or viewing *history* (col.74, ln.67). Clearly, Hendricks does not contemplate collecting viewing-habit data dynamically. For this reason alone, Hendricks fails to anticipate every element of claim 19.

The concept of presenting multimedia messages during downloading breaks in program transmissions is claimed in claim 19 in the final "wherein" clause as follows:

"presenting the first viewer multimedia messages when there is a downloading delay in the availability of the multimedia content for presentation at the viewing station."

On page 4 of the Office Action, the Examiner notes that Hendricks presents multimedia messages when there is a break in the availability of the multimedia content, and cites to col.73, ln.27-35; col.27, ln.18-28, 39-45. However, there is no suggestion in any of these sections, nor anywhere else in the Hendricks disclosure, that "program breaks" can arise from *downloading delays* introduced by Internet transmissions. Hendricks clearly limits program breaks to the familiar "commercial break" that is administratively inserted during a conventional television broadcast. *See* Hendricks, col.27, ln.16-38, 39-45; col.73, ln.28. Clearly, Hendricks does not contemplate presenting pre-cached sponsored messages during unplanned downloading delays. Hendricks therefore fails to anticipate every element of claim 19.

As for the Zigmond reference, Applicants note again that this reference was cited only for its teachings related to providing login protocols. Like Hendricks, it contains no suggestions or motivations to compile viewing habits dynamically, or to present multimedia messages during downloading breaks in program transmissions. It cannot therefore form the basis for a §103(a) rejection, either alone or in combination with Hendricks.

c. <u>In view of the Amendments, Hendricks and Zigmond cannot form the basis for a §103(a) rejection because they fail to teach or suggest all elements of claim 43</u>

In response to the rejection of claim 43, Applicants submit that the combination of Hendricks and Zigmond fails to anticipate every element of claim 43, as amended. In particular, neither reference anticipates or suggests presenting multimedia messages during *downloading* breaks in program transmissions.

The concept of presenting multimedia messages during downloading breaks in program transmissions is claimed in claim 43 in step (f) and in the final "wherein" clause, as follows:

"presenting the pre-cached sponsored message at the viewing station at a time when the multimedia content is at least substantially not available;

wherein the multimedia content is not available because (d) includes a downloading delay in the delivering of the multimedia content."

For the same reasons presented above in section II.b regarding the novelty of presenting messages during downloading breaks, Applicant asserts that neither Hendricks nor Zigmond, nor any combination of the two, anticipates or suggests every element of claim 43. Therefore these references cannot form the basis for a §103(a) rejection.

III. Conclusion

In view of all of the above, Applicants respectfully request that the Examiner withdraw all rejections and pass this Application to issuance.

In papers submitted with this Response, Applicants have authorized the Commissioner to charge the fee set forth under 37 C.F.R. § 1.20(d) for a two-month extension of time. Applicants believe no other fees are due. If any additional fees are in fact due, the Commissioner is hereby authorized to charge Howrey Deposit Account No. **08-3038** for the same referencing Howrey Dkt. No. **05742.0004.NPUS00**.

Respectfully submitted,

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